

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicants : Mike O'Donnell and Andrew Cameron
Application No. : 09/245,798
Confirmation No. : 5408
Appeal : 2010-001885
Filed : February 5, 1999
For : AUTOMATED LICENSING AND DELIVERY OF COPIES OF
WORKS OF AUTHORSHIP, WITH PROOF OF LICENSING

Examiner : Beth Boswell
Art Unit : 3623
Docket No. : IC1.005.US
Date : May 19, 2011

Request for Rehearing

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Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Appellant requests a rehearing from the BPAI decision of March 30, 2011 (“the decision”).

Points Misapprehended

The theory of obviousness, for claim 129, presented by the Board, that “adjusting the security settings in the Johnson method would have been no more than the use of a known method to produce a predictable result and as such would have been obvious at the time of the invention”

has not been presented before in this case. Accordingly, appellants have not previously had an opportunity to address this position. The point misapprehended is the mistaken belief that the above-quoted statement meets the requirements for a finding of obviousness imposed on the USPTO by the United States Supreme Court in *KSR v. Teleflex*, 550 US 398 (2007). This statement does not meet these requirements because it ignores the requirement to show that a person having ordinary skill in the art would have *seen a benefit* in modifying the teachings of Johnson (US Patent 5,991,876, iss. Nov. 23, 1999) to implement the method of claim 129 or the system of claim 145.

In an additional point misapprehended, the Board appears to believe that only claims 126 and 129 were appealed and argued separately in this case, but claim 128 (paired with parallel system claim 142) was also appealed and argued separately (see Reply Brief, page 47). Appellants ask that the Board address claim 128 in its response to this Request, so that the case will have a full record, in the event that appeal to the Court of Appeals for the Federal Circuit is necessary.

Analysis

The Syllabus Holding of *KSR* provides that, “[i]f a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability.” *KSR v. Teleflex*, 550 US 398, 401 (2007) (emphasis added). Appellants note that this statement from the holding reiterates a portion of a statement quoted by the Board in its decision, but also clarifies that there must be an apparent benefit for introducing the variation. As the Syllabus Holding is written by the Court explicitly to serve as legal authority, it follows that the language therein is the most authoritative. Moreover, it would appear that the above-cited language incorporates a requirement that is also introduced in the body of the case discussion. This is shown, at least, by the following text, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge *possessed by a person* having ordinary skill in the art, all in order to determine whether there was *an apparent reason to combine the known elements in the fashion claimed by the patent at issue*. To facilitate review, this analysis should be made explicit.” *Id.* at 411 (emphasis added).

The failure of the PTO to show that a person of ordinary skill in the art “would see the benefit of” implementing the method of 129, provided that he was familiar with the teachings of Johnson, is a fatal flaw that will not stand court review. The PTO has never provided a rationale for a position that a person having ordinary skill in the art would understand that there was a benefit to be gained from making licensee information available over a public network. Indeed although the Board states that modifying Johnson to meet the claim language would yield a predictable result, the Board has not provided appellants with any indication of what that predictable result might be. Surely, to support its conclusory assertion that there *is* a predictable result, the PTO must identify a predictable result.

To show that a person having ordinary skill in the art would see a benefit from the modification, it follows that whatever predictable result is identified should be a result having obvious benefits. This precludes the predictable result stated by the Examiner in the first full paragraph of page 23 of the Answer Brief, of “allowing anyone to access the data over the internet ...” as there is no reason to believe that a person of ordinary skill in the art would understand that a benefit would be gained from this result.

Appellants have steadfastly held to the position that making the licensee information available over a public network provides benefits that are as subtle as they are far reaching. Our contention that a person having ordinary skill in the art would not take this action, because he would not understand that subtle benefits are yielded by doing so, has never been contradicted by any argument presented by the PTO. By permitting licensees to show recipients that they have indeed lawfully licensed, those who distribute unlawfully copied works are made more conspicuous and thereby more likely to be turned in to a whistle blower program or to encounter disapproval. This creates an incentive to license, before copying and further distribution. This benefit is real, but the original perception of it required true imagination and insight. This is evidenced by the singular nature of the advancement, which nobody (including the Johnson patent inventors) thought of, except for the present inventors.

Accordingly, the rejection of claim 129, and the parallel system claim, 145, must be withdrawn.

Respectfully Submitted,

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